

REMARKS

Claims 1 - 23 were pending in the present application. Claims 1-5 have been cancelled without prejudice. The Examiner provides two alternative 103 rejections and we list them here in the order in which they are addressed:

- I. Claims 1 - 17 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Dorman *et al.*.
- II. Claims 1 - 17 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Coombes *et al.*.

1. The Office Action Is Incomplete

Claims 1-23 were pending in the present application. The Examiner indicates in the Office Action of May 6, 2003 (hereafter "Office Action") in the "Office Action Summary" page that all pending Claims (1-23) are rejected. However, the Office Action's "Detailed Action" section refers only to rejections of Claims 1-17 as being obvious. The basis for rejecting Claims 18-23 is not found in the office action. It is not proper examination to deal with some claims and ignore others. The Examiner's action needs to "be complete as to all matters . . ." MPEP 707.07

Of particular note is Claim 23, which is an independent claim specifying a particular ratio of components. Neither Claim 23 nor the ratio of components are discussed. This is not proper examination. This is certainly inappropriate for a FINAL office action.

Indeed, the ratios specifically set forth in Claims 15-17 are not discussed. Again, this is not proper examination.

The office action refers to Claim 15 specifically. However, it appears the Examiner mistakenly believes that Claim 15 has a porosity element:

"It would appear that the degree of porosity reached by the process employed in the reference . . . would meet the claimed broad limits (instant claim 15)."

(Office Action, p. 2). Claim 15 does not have a porosity limitation. Thus, the rejection of Claim 15 is called into question.

Finally, the office action apparently ignores limitations in the claims. More specifically, in applicants' last response, it was pointed out that the Examiner did not consider the element of "simulated body fluid" when reviewing Claim 6. (Response, p.8) The Examiner, at that time, was directed to the definition of that term in the specification. Unfortunately, the Examiner remains silent in the current office action with regard to this claim element. The Examiner is reminded that "*before* final rejection is in order a *clear* issue should be developed between the examiner and the applicant." MPEP 706.07 By ignoring the claim element - and then ignoring applicants specific request to take note of the claim element - the Examiner has not developed the clear issues required for examination.

In sum, the Examiner has (at best) done a partial examination of the claims. This is not proper. Such an office action is deficient.

2. The Final Rejection Is Premature

In view of the deficiencies of the office action, the finality should be withdrawn. Therefore, the RCE is filed under protest. A petition to withdraw the finality of the office action is filed herewith as a separate paper pursuant to MPEP 1002.02(c) on the grounds that the final office action was incomplete and therefore premature.

3. The Claims Are Not Obvious

Applicants re-affirm the arguments made previously. Nonetheless, without acquiescing to the Examiner rejection, but to further the prosecution, and hereby expressly reserving the right to prosecute the claims (or similar claims) in the future, Claims 1-5 have been cancelled.

With regard to Claim 15 (and similar claims that contain ratios), the Examiner must find the claimed ratio of ingredients in the prior art or provide a basis for why such ratios are obvious. Instead, the Examiner simply leaps to the conclusion that "It would appear that the degree of porosity reached by the process employed in the reference would meet the claimed broad limits (instant claim 15)" (Office Action, para. 3). Such inherency arguments must be supported by teachings from the cited references or other teachings from those skilled in the art. But here, the Examiner's hypothesis lacks the requisite evidentiary support.

It is not enough for the Examiner to make assumptions. "[T]he examiner's assumptions do not constitute the disclosure of the prior art." *In re Rijckaert*, 9 F.3d 1531, 28

USPQ2d 1955, 1956 (Fed. Cir. 1993). It is also not permitted that the Examiner read elements into the prior art that are, in fact, not stated. "[W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears." *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

The Examiner is reminded that the burden is on the PTO in the first instance.¹ The burden shifts to the applicants only after the requisite evidentiary basis for a rejection has been established. Such is not the case here.

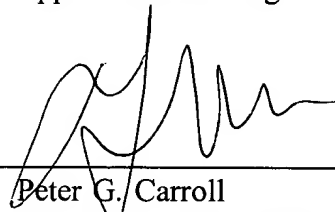
With respect to Claim 23, the Examiner has offered nothing. Claim 23 is not even discussed.

With respect to Claim 6 (and claims dependent thereon), the Examiner has said nothing about the element "simulated body fluid." Without this element, the Examiner's rejection must fail (even if the cited art is improperly combined). Applicants, to stress that the element is part of the claim, have imported language from the definition into Claim 6.

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

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¹ "[T]he rule is that the burden of persuasion is on the PTO to show why the applicant is not entitled to a patent." *In re Epstein*, 31 USPQ2d 1817, 1825 (Fed. Cir. 1994) (Plager, J. joined by Cowen, J., concurring.) (citing to *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) (Plager, J., concurring); *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968)).